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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,475	02/07/2001	Lori P. Engle	55188USA9C.014	4701

7590

09/10/2002

Attention: Scott A. Bardell
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/10/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-2

Office Action Summary	Applicati n N .	Applicant(s)	
	09/778,475	ENGLE ET AL.	
	Examiner	Art Unit	
	Michael E. Grendzynski	1774	

-- The MAILING DATE f this communication appears on the c ver sheet with the correspondence address --

Period f r R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-27 and 30-32, drawn to a method of providing a durable image and a kit, classified in class 427, subclass 331.
 - II. Claims 27-29, drawn to a printed article, classified in class 428, subclass 195.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another, materially different process, e.g., by coating the substrate with the aqueous coating, printing or transferring an image onto the coated surface; applying a dispersed hydrophobic material onto the image, and polymerizing the hydrophobic material.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. In the event that the invention of Group I is elected, this application contains claims directed to the following patentably distinct species of the claimed invention: A method of providing durable images comprising:
 - a. (1) coating a surface of a substrate with an aqueous mordant dispersion; (2) printing a selected image onto the coated surface; (3) applying a dispersed hydrophobic material to the image and (4) drying the hydrophobic material (claims 1, 3-6 and 10-12);

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- b. (1) coating a surface of a substrate with an aqueous mordant dispersion; (2) transferring a selected image onto the coated surface; (3) applying a dispersed hydrophobic material to the image and (4) drying the hydrophobic material (claims 1, 3-6 and 10-12);
- c. (1) coating a surface of a substrate with an aqueous mordant dispersion; (2) printing a selected image onto the coated surface; (3) applying a dispersed hydrophobic material to the image; (4) drying the hydrophobic material and (5) heating the substrate above ambient temperature (claims 2 and 13);
- d. (1) coating a surface of a substrate with an aqueous mordant dispersion; (2) transferring a selected image onto the coated surface; (3) applying a dispersed hydrophobic material to the image; (4) drying the hydrophobic material and (5) heating the substrate above ambient temperature (claims 2 and 13);
- e. (1) coating a surface of a substrate with an aqueous mordant dispersion; (2) drying the aqueous mordant dispersion; (3) printing a selected image onto the coated surface; (4) applying a dispersed hydrophobic material to the image and (5) drying the hydrophobic material (claims 7-9);
- f. (1) coating a surface of a substrate with an aqueous mordant dispersion; (2) drying the aqueous mordant dispersion; (3) transferring a selected image onto the coated surface; (4) applying a dispersed hydrophobic material to the image and (5) drying the hydrophobic material (claims 7-9);

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- g. (1) coating a surface of a substrate with a mixture comprising an aqueous mordant dispersion and a dispersed hydrophobic material; (2) printing a selected image onto the coated surface; (3) drying the image and the coated mixture (claims 14 and 16-21);
- h. (1) coating a surface of a substrate with a mixture comprising an aqueous mordant dispersion and a dispersed hydrophobic material; (2) transferring a selected image onto the coated surface; (3) drying the image and the coated mixture; (claims 14 and 16-21);
- i. (1) coating a surface of a substrate with a mixture comprising an aqueous mordant dispersion and a dispersed hydrophobic material; (2) printing a selected image onto the coated surface; (3) drying the image and the coated mixture and (4) heating the substrate of ambient temperature (claim 15);
- j. (1) coating a surface of a substrate with a mixture comprising an aqueous mordant dispersion and a dispersed hydrophobic material; (2) transferring a selected image onto the coated surface; (3) drying the image and the coated mixture and (4) heating the substrate of ambient temperature (claim 15);
- k. (1) coating a surface of a nonporous substrate with an aqueous fluoropolymer dispersion; (2) printing a selected image onto the coated surface and (3) heating the printed image above ambient temperature (claims 22 and 24-26);
- l. (1) coating a surface of a nonporous substrate with an aqueous fluoropolymer dispersion; (2) transferring a selected image onto the coated surface and (3) heating the transferred image above ambient temperature (claims 22 and 24-26);
- m. (1) coating a surface of a nonporous substrate with an aqueous fluoropolymer dispersion; (2) drying the dispersion at ambient temperature; (3) printing a selected image

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onto the coated surface and (4) heating the printed image above ambient temperature (claim 23); or

n. (1) coating a surface of a nonporous substrate with an aqueous fluoropolymer dispersion; (2) drying the dispersion at ambient temperature; (3) transferring a selected image onto the coated surface and (4) heating the transferred image above ambient temperature (claim 23).

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or *clearly admit on the record* that this is the case. In either instance, if the

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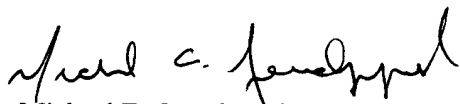
examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

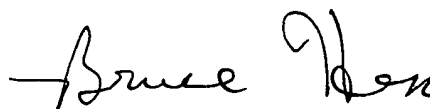
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.


Michael E. Grendzynski
Assistant Examiner
September 7, 2002



BRUCE H. HESS
PRIMARY EXAMINER